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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,469	08/01/2003	Michael A. Wack	DEP673-CIP	4800
27777	7590	10/18/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,469

Applicant(s)

WACK ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 8/1/03; 2/17/04; 8/22/05.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION***Election/Restrictions***

Applicant's election without traverse of the invention of Group I (claims 1-27 and 30-33) in the reply filed on July 31, 2006 is acknowledged. Accordingly, this office addresses claims 1-27 and 30-33 on the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 and 30-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 38, 39, 46 and 51 of copending Application No. 10/100,387 ('387 herein) in view of Wagner et al. (US 6,030,389).

Claims 38, 39, 46 and 51 of '387 disclose all elements of the claimed invention except for a bushing with a generally spherical exterior surface.

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Wagner et al. teach providing a bushing with a curved or generally spherical exterior surface in a borehole of a plate so that a screw may be rotated and moved to various positions within the borehole (Figs. 2-4 and col. 6, lines 34-67 and col. 7, lines 1-14).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a bushing with a generally spherical exterior surface, as taught by Wagner et al., in a borehole of the plate of the system of the claims 38, 39, 46 and 51, to enable rotation and movement of a screw to various positions within the borehole in the system of the combination of claims 38, 39, 46 and 51 and Wagner et al.

Claims 1-27 and 30-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 35, 42, 49 and 55 of copending Application No. 10/100,387.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the present application and the claims of the copending application is that the claims of the copending application include many more elements and are thus more specific. Thus the invention of the claims of copending application is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claims of the copending application, they are not patentably distinct from the claims of the copending application.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bono (US 5,954,722).

Bono discloses a fracture repair system including: a plate 10; a bushing 16 with a spherical exterior surface; a first screw or "head attachment component" 18 with a cap portion; and a second screw or "body attachment component" 18 with a cap portion (Figs. 5 and 6, col. 3, lines 48-67, cols. 4-5 and col. 6, lines 1-30).

Claims 7-9, 11-15, 17-19, 21, 22-24, 26-27 and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Weaver et al. (WO 01/19267 A1).

Weaver et al. disclose a fracture repair system including: a first plate 50; a second plate 80; non-locking screws 10 with cap portions 12; and locking screws 20 with cap portions 22 wherein combining locking and non-locking screws in the same bone plate provides mixed fixation (Figs. 1-2, 7-8 and 20-21, page 8, lines 12-22 and pages 9-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 16, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al. (WO 01/19267 A1) in view of Wagner et al. (US 6,030,389).

Weaver et al. disclose all elements of the claimed invention except for a bushing with generally spherical exterior surface.

Wagner et al. teach providing a bushing with a curved or generally spherical exterior surface in a borehole of a plate so that a screw may be rotated and moved to

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various positions within the borehole (Figs. 2-4 and col. 6, lines 34-67 and col. 7, lines 1-14).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a bushing with a generally spherical exterior surface, as taught by Wagner et al., in a borehole of either of the Weaver et al. plates 50, 80 in the system of the combination of Weaver et al. and Wagner et al., to enable rotation and movement of a screw to various positions within the borehole.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

October 16, 2006

